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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/761,726	01/21/2004	Yury M. Podrazhansky	4E09.1-020	3657

25207 7590 12/01/2006

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EXAMINER

DEMILLE, DANTON D.

ART UNIT	PAPER NUMBER
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3771

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/761,726

Applicant(s)

PODRAZHANSKY ET AL.

Examiner

Danton DeMille

Art Unit

3771

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Danton DeMille
Primary Examiner
Art Unit: 3771

Continuation of 11. does NOT place the application in condition for allowance because: This CAFC decision is based on a chemical composition for treating skin damage that discloses eight distinct example compositions with specific concentrations of ingredients. It was held that a composition to one of those ingredients cannot anticipate because it appears without special emphasis in a longer list of elements or that millions of compounds does not render obvious a claim to three compounds. It is not clear how much patentable weight can be given the court decision because the instant invention is not a chemical composition in which a specific combination of elements are being claimed. It is a method of using a vibrator at a lower frequency sweep and a higher frequency sweep. There are only two claimed "compounds" and the prior art teaches one range with the option of including another range. The prior art teaches the two claimed "compounds" and the rejection is not picking just one or somehow modifying the composition or arrangement of "compounds". The claims recite the two options and the prior art teaches the two options. It is not clear at all how this issue is relevant to the issues at hand.

The decision is also based on whether the prior art teaches the claimed range. The claimed invention recites a range "up to 10% by weight" with dependent claims reciting ranges within this range. The prior art discloses a range "from 0.01 to 20% by weight" and therefore the court held that they would sustain the district court's reading of the effective amount anticipates the claimed range. This issue would appear to be appropriate in this case because the claims recite a lower frequency below 100 Hz and a higher frequency above 100 Hz. The prior art teaches a sweep of 40 - 160 Hz which includes the higher range of above 100 Hz and the prior art teaches the additional option to include a frequency sweep that begins at a lower range of 16 Hz and upwards in order to excite a Helmholtz resonance. Therefore this issue is likewise sustained.

The decision is also based on the argument that the prior art will not inherently function in the same claimed beneficial manner. The prior art teaches the method of topical application of the lotion and not for the treatment of skin sunburn. Therefore the claims recite a new use of the composition disclosed by the prior art. In the instant application the prior art teaches a method of dislodging or loosening mucus in a person's lungs. The claims recite a device and process to benefit a living body. Here the prior art teaches a method that benefits a living body by dislodging or loosening mucus from a person's lungs and therefore is beneficial and anticipates the invention as claimed. Just as the court decision later affirms the lower court's decision of anticipation for a different set of claims where it merely requires application of the composition to exposed skin surfaces, the issues here are equivalent and therefore are sustained.